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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
10/506,506	09/03/2004	Yuichi Kanai	041-465-5240	2738
55694 7590 04/15/2008 DRINKER BIDDLE & REATH (DC) 1500 K STREET, N.W. SUITE 1100 WASHINGTON, DC 20005-1209				
EXAMINER				
ABDUL-ALL, OMAR R				
ART UNIT		PAPER NUMBER		
2178				
MAIL DATE		DELIVERY MODE		
04/15/2008		PAPER		

Please find below and/or attached an Office communication concerning this application or proceeding.

The time period for reply, if any, is set in the attached communication.

Office Action Summary

Application No.

10/506,506

Applicant(s)

KANAI ET AL.

Examiner

OMAR ABDUL-ALI

Art Unit

2178

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --
Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

- 1) ☒ Responsive to communication(s) filed on 13 March 2008.
- 2a) ☒ This action is **FINAL**. 2b) ☐ This action is non-final.
- 3) ☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

- 4) ☒ Claim(s) 1-10 is/are pending in the application.
- 4a) Of the above claim(s) _____ is/are withdrawn from consideration.
- 5) ☐ Claim(s) _____ is/are allowed.
- 6) ☒ Claim(s) 1-10 is/are rejected.
- 7) ☐ Claim(s) _____ is/are objected to.
- 8) ☐ Claim(s) _____ are subject to restriction and/or election requirement.

Application Papers

- 9) ☐ The specification is objected to by the Examiner.
- 10) ☐ The drawing(s) filed on _____ is/are: a) ☐ accepted or b) ☐ objected to by the Examiner.
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11) ☐ The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

Priority under 35 U.S.C. § 119

- 12) ☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).
- a) ☐ All b) ☐ Some * c) ☐ None of:
1. ☐ Certified copies of the priority documents have been received.
 2. ☐ Certified copies of the priority documents have been received in Application No. _____.
 3. ☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

Attachment(s)

- 1) ☒ Notice of References Cited (PTO-892)
- 2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
- 3) ☐ Information Disclosure Statement(s) (PTO/SF/ICE)
Paper No(s)/Mail Date _____
- 4) ☐ Interview Summary (PTO-413)
Paper No(s)/Mail Date _____
- 5) ☐ Notice of Informal Patent Application
- 6) ☐ Other: _____

DETAILED ACTION

The following action is in response to the response filed March 13, 2008. Amended Claims 1-10 are pending and have been considered below.

1. The prior art rejections of Claims 1-10 have been withdrawn as necessitated by the disqualification of the Murakami (US 2003/0049029) reference under 35 U.S.C. 102(e).

Claim Rejections - 35 USC § 103

2. The following is a quotation of 35 U.S.C. 103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

3. Claims 1-10 rejected under 35 U.S.C. 103(a) as being unpatentable over Ueda et al. (US 2001/0005442) in view of Ahmad et al. (US 6,880,171) and further in view of Ouzts et al. (US 2003/0076322).

Claims 1, 4, and 7: Ueda discloses an information edition device, method, and program for editing a logical format of recorded AV information in a recording medium, comprising a first selecting device for selecting a thumbnail image from images corresponding to image information included in the recorded AV information, but does not explicitly disclose the logical recording format comprises a flag that indicates whether an image included in the recorded AV information or an image not included in

the recorded AV information should be used as a thumbnail. Ahmad discloses selecting an image from the recorded video data or selecting an image from a library of video images (column 18, lines 57-67). Setting a flag to indicate different choices is common in the computer arts, as indicated by Ouzts, who discloses using a GetLocation method to specify the flags as to how a thumbnail image should be rendered. The GetLocation method is part of the IExtractImage interface routine which is used to obtain a representative thumbnail either from the cache or create a thumbnail if a thumbnail has not been generated. It would have been obvious to one having ordinary skill in the art at the time the invention was made to provide the logical recording format with a flag that indicates whether an image included in the recorded information or an image not included in the recorded information should be used as a thumbnail in Ueda. One would have been motivated to include this limitation for customization purposes.

Ahmad further discloses a second selecting device for selecting a thumbnail image from images not included in the image information of the recorded information (column 18, starting at line 64). Specifically, Ahmad discloses manually selecting a thumbnail from a library of video images instead of from the recorded information. Therefore, it would have been obvious to one having ordinary skill in the art at the time the invention was made to select an image from images not included in the image information of the recorded information. One would have been motivated to include this limitation for customization purposes. Ahmad further discloses the determination of which image to use (i.e. from the recorded information or not included in the recorded information) can be automatic or manual, which provides reasonable suggestion that a

controlling device is adapted to determine whether the image selected by the first selecting device or the image selected by the second selecting device should be specified as the thumbnail image.

Ueda discloses a recording device for recording first position information and second position information on the recording medium, the first position information indicating on the recording medium a recording position of image information corresponding to the image selected by the first selecting device, the second position information indicating on the recording medium a recording position of image information corresponding to the image selected by the second selecting device (page 4, paragraph 55), but does not explicitly disclose setting the flag in accordance with the determination of the controlling device. However, setting a flag to indicate different choices is common in the computer arts, as indicated by Ouzts, who discloses using a `GetLocation` method to specify the flags as to how a thumbnail image should be rendered. The `GetLocation` method is part of the `IExtractImage` interface routine which is used to obtain a representative thumbnail either from the cache or create a thumbnail if a thumbnail has not been generated. Though Ueda does not explicitly disclose using a flag, it is obvious that some type of flag or indication of a choice is being used in the system when choosing a thumbnail. One would have been motivated to set a flag in accordance with the determination of the controlling device in order to indicate a selection.

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Claims 2, 5, and 8: Ueda, Ahmad, and Ouzts disclose an information edition device, method, and program, as in Claims 1, 4, and 7 above, and Ueda further discloses:

a. the thumbnail image selected by the second selecting device is an image obtained from external image information or an image recorded beforehand on the recording medium other than the images corresponding to the image information in the recorded information (page 3, paragraph 73).

Claims 3, 6, and 9: Ueda, Ahmad, and Ouzts disclose an information edition device, method, and program, as in Claims 1, 4, and 7 above, and Ueda further discloses:

a. when another image is selected by the second selecting device after the second position information is recorded, the recording device rerecords a recording position of image information, which corresponds to the additionally selected image, as new second position information on the recording medium (page 3, paragraph 73).

Claim 10: Ueda, Ahmad, and Ouzts disclose an information edition recording medium for recording the information editing program according to Claim 7 (page 2, paragraph 36).

Response to Arguments

6. Applicant's arguments with respect to claims 1-10 have been considered but are moot in view of the new ground(s) of rejection.

Conclusion

7. Applicant's amendment necessitated the new ground(s) of rejection presented in this Office action. Accordingly, **THIS ACTION IS MADE FINAL**. See MPEP § 706.07(a). Applicant is reminded of the extension of time policy as set forth in 37 CFR 1.136(a).

A shortened statutory period for reply to this final action is set to expire **THREE MONTHS** from the mailing date of this action. In the event a first reply is filed within **TWO MONTHS** of the mailing date of this final action and the advisory action is not mailed until after the end of the **THREE-MONTH** shortened statutory period, then the shortened statutory period will expire on the date the advisory action is mailed, and any extension fee pursuant to 37 CFR 1.136(a) will be calculated from the mailing date of the advisory action. In no event, however, will the statutory period for reply expire later than **SIX MONTHS** from the date of this final action.

Any inquiry concerning this communication or earlier communications from the examiner should be directed to OMAR ABDUL-ALI whose telephone number is (571)270-1694. The examiner can normally be reached on Mon-Fri(Alternate Fridays Off) 8:30 - 6:00 EST.

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Stephen Hong can be reached on 571-272-4124. The fax phone number for the organization where this application or proceeding is assigned is 571-273-8300.

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Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, contact the Electronic Business Center (EBC) at 866-217-9197 (toll-free). If you would like assistance from a USPTO Customer Service Representative or access to the automated information system, call 800-786-9199 (IN USA OR CANADA) or 571-272-1000.

OAA
4/04/2008

/Stephen S. Hong/
Supervisory Patent Examiner, Art
Unit 2178